

REMARKS

As a preliminary matter, it is noted that the Examiner has not provided an initialed copy of the Information Disclosure Statements filed on December 14, 2001, October 28, 2003 and January 16, 2004. A copy of each of the Information Disclosure Statements and stamped-post cards showing receipt by the PTO is attached hereto for the Examiner's reference. It is respectfully requested that the Examiner provide Applicants an initialed copy of the Information Disclosure Statements indicating that each of the prior art references cited therein have been considered and made of record.

The indication of allowable subject matter in claims 4, 5, 9, 14, 15, 19, 40, 41, 45, 53, 54 and 58 is acknowledged and appreciated. In view of the following remarks, it is respectfully submitted that all claims are in condition for allowance.

In order to expedite prosecution and consolidate Applicants' application, each of the withdrawn independent claims have been amended in a manner similar to the elected independent claims and are submitted to be allowable for at least reasons similar to those discussed below regarding the elected claims. Accordingly, Applicants respectfully request that the Examiner rejoin the withdrawn claims.

Claims 1-3, 6-8, 10-13, 16-18, 20-23, 28-31, 36, 37, 39, 42-44, 46-48, 52, 55-57, 60, 65 and 66 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Jang et al. '375 ("Jang"), claims 1-3, 6-8, 10-13, 16-18, 20-23, 36-39, 42-44, 46, 48-52, 55-57 and 59-70 stand rejected

under 35 U.S.C. § 102(b) as being anticipated by Taniguchi et al. '134 ("Taniguchi"), and claims 67-70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jang in view of Kataoka et al. '111. Claims 1, 2, 22, 24, 26, 28, 30, 32-37, 63 and 65-72 are independent. These rejections are respectfully traversed for the following reasons.

Each of the independent claims have been amended to recite a design arranged "regularly according to a predetermined rule so as to have a reproducible" characteristic. Support for this feature can be found, for example, on page 4, lines 12-16 of Applicants' specification. One exemplary embodiment of providing such a design is described, for example, on page 23, line 11 – page 27, line 10 of Applicants' specification.

In contrast, Taniguchi expressly discloses that "the dots are formed and disposed at *random* ..." (emphasis added; col. 3, lines 11-12). Taniguchi further discloses that "[i]n the course of developing the color liquid crystal display device ... various *random* dot patterns have been prepared and examined, as a result of which it has been formed that the random dot pattern should be so formed and disposed as to meet the requirements described hereinbefore in conjunction with the aspects or features of the invention" (emphasis added; col. 12, lines 17-24). To meet this end, Taniguchi discloses first preparing a random dot pattern which is thereafter adjusted to meet certain requirements. Accordingly, the resulting design is not arranged *regularly* according to a predetermined rule because it originates from a *random initial design*. Taniguchi describes the method of forming the initial design at col. 15, lines 24+:

as a method of determining the coordinates (x, y) of the dots disposed at *random without regularity*, there is proposed according to the present invention a high-efficiency dot coordinates determining method which includes the steps or procedures described below ... Random number are generated by making use of random number generating function incorporated in a computer or the like, and the random number as generated are used to determine the coordinates (x, y) for the random dot disposition. (emphasis added)

Jang, on the other hand, is at best cumulative to the admitted prior art described on page 2, lines 24-30 of Applicants' specification. That is, Jang merely discloses that distances between adjacent polygons 118a, 118c are varied within a predetermined range (*see, e.g.*, col. 4, lines 48-52). In fact, Jang is further removed from the present invention in that, similar to Taniguchi, the *initial* design is determined using a *random* generator (*see, e.g.*, col. 6, lines 10-16).

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that neither Taniguchi nor Jang anticipate the independent claims, nor any claim dependent thereon.

The Examiner is further directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for a § 103 rejection:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 67-70 because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable

for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on all the foregoing, it is submitted that claims 1-84 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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